REMARKS

Assignee respectfully requests entry of the following amendments and remarks in response to the Non-Final Office Action mailed November 5, 2010. Assignee respectfully submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1, 2, 10, 11, 18, and 26-27 are pending. In particular, Assignee amends claims 1, 10, 11, 18, and 26-27. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

The Examiner is encouraged to contact Assignee's attorney, after reviewing the present response, to resolve or discuss _any_ questions or outstanding issues in an effort to expedite examination of the present application.

II. Support for Claim Language

In response to the last Response, the Office Action states "Applicant is requested to provide support for the new/amended claims." Page 2. Accordingly, the Examiner is directed to page 12 showing examples of rule criterion, including "Is the sender currently logged into BIM and present?" and "Message is from a given internet domain," and page 5 showing examples of rule actions including "Open a Chat window to the Sender of the Message." This corresponds to the claim amendments made in the prior Response. Page 21 of the present application describes bypassing spam or Bayesian filtering corresponding to the claim amendments made in the present Response.

III.   Response to Rejections under 35 U.S.C. §112

The Office Action rejected claims 1, 2, 10, 11, 18, 26, and 27 under 35 U.S.C. §112, second paragraph as being indefinite. In particular, the Office Action objected to the term "the receiving email message" in independent claims 1, 10, 18, and 26 for not having proper antecedent basis. The term has been amended to state "the received email message" which has proper antecedent basis. Accordingly, withdrawal of the rejection is respectfully requested.

The Office Action also rejected independent claim 18 under 35 U.S.C. 112, sixth paragraph. To address the Examiner's concerns, the means for language has been removed from the claim. Accordingly, withdrawal of the rejection is respectfully requested.

IV.   Response to Rejections under 35 U.S.C. §101

The Office Action rejected claims 10-11 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. To address the Examiner's concerns, the claims have been amended to recite a "non-transitory" computer-readable storage medium. Withdrawal of the rejection is respectfully requested.

V.   Rejections under 35 U.S.C. §103

The Office Action indicates that claims 1-2, 10-11, 18-20, and 25-27 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 6,839,737 ("*Friskel*") in view of U.S. Patent Publication Number 2002/0049961 ("*Fang*") further in view of U.S. Patent Publication Number 2005/0091319 ("*Kirsch*").

Independent claim 1 recites:

> A method for initiating an instant messaging (IM) session, the method comprising:
> ***receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are***

satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account;
  determining whether the received email message is from the given Internet domain;
  determining whether the sender of the received email message is currently present at the instant messaging account;
  determining whether the sender of the received email message is a contact of a recipient of the received email message;
  in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messging session with the sender and bypassing spam filtering of the received email message; and
  in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account.

(Emphasis added).

Claim 1 is allowable over *Friskel* in view of *Fang* further in view of *Kirsch* for at least the reason that *Friskel* in view of *Fang* further in view of *Kirsch* fails to disclose, teach, or suggest "receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account" and "in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically

launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as emphasized above.

More specifically, *Friskel* discloses that a client user may initiate communications with any sender whose status information indicates that the sender is online and available. *See* col. 7, lines 46-55. *Friskel* does not disclose a rule that specifies that the received email message from the sender needs to be from a given Internet domain in addition to the sender being online. Accordingly, *Friskel* fails to teach or suggest "receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account" and "in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as recited in claim 1.

Fang does not remedy these deficiencies. For example, *Fang* describes "a framework for allowing personalized rules to be created and deployed to a live web site, through a web interface, without further programming efforts and without interrupting the web site." Paragraph 0044. As such, *Fang* does not disclose or suggest a rule for automatically launching an instant messaging session with a sender of a received email message when the received email message is from a given Internet domain. Further, *Kirsch* describes an email filter that receives an incoming email message and checks whether a sender of the email message is on a whitelist or a blacklist or should be associated with domain names that are on a

whitelist/blacklist. See paragraph 0027 and paragraph 0072. Accordingly, the email filter determines whether or not the email message is placed in the recipient's inbox and does not affect outgoing communications from the recipient such as an instant messaging session automatically launched with a sender of a received email message when the received email message is from a given Internet domain. Accordingly, *Kirsch* fails to remedy the deficiencies of *Friskel* and *Fang*.

Moreover, the cited art fails to teach or suggest at least 'in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account," as recited in claim 1. For at least these reasons, claim 1 is allowable. Dependent claim 2 is allowable for at least the reason that this claim depends from and includes the features of allowable independent claim 1.

Independent claim 10 recites:

> A non-transitory computer-readable storage medium that includes a program that when executed by a computer performs at least the following:
> *receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant iessaging account;*
> determining whether the received email message is from the given Internet domain;
> determining whether the sender of the received email message is currently present at the instant messaging account;
> determining whether the sender of the received email message is a contact of a recipient of the received email message;
> *in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of*

> *the received email message;* and
>> in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account.

(Emphasis added).

Claim 10 is allowable over *Friskel* in view of *Fang* further in view of *Kirsch* for at least the reason that *Friskel* in view of *Fang* further in view of *Kirsch* fails to disclose, teach, or suggest "receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account" and "in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as emphasized above.

More specifically, *Friskel* discloses that a client user may initiate communications with any sender whose status information indicates that the sender is online and available. *See* col. 7, lines 46-55. *Friskel* does not disclose a rule that specifies that the received email message from the sender needs to be from a given Internet domain in addition to the sender being online. Accordingly, *Friskel* fails to teach or suggest "receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received

email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account" and "in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as recited in claim 10.

Fang does not remedy these deficiencies. For example, *Fang* describes "a framework for allowing personalized rules to be created and deployed to a live web site, through a web interface, without further programming efforts and without interrupting the web site." Paragraph 0044. As such, *Fang* does not disclose or suggest a rule for automatically launching an instant messaging session with a sender of a received email message when the received email message is from a given Internet domain. Further, *Kirsch* describes an email filter that receives an incoming email message and checks whether a sender of the email message is on a whitelist or a blacklist or should be associated with domain names that are on a whitelist/blacklist. See paragraph 0027 and paragraph 0072. Accordingly, the email filter determines whether or not the email message is placed in the recipient's inbox and does not affect outgoing communications from the recipient such as an instant messaging session automatically launched with a sender of a received email message when the received email message is from a given Internet domain. Accordingly, *Kirsch* fails to remedy the deficiencies of *Friskel* and *Fang*.

Moreover, the cited art fails to teach or suggest at least 'in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a

given Internet domain and the second criteria specifies that the sender of the received email

message is currently present at an instant messaging account," as recited in claim 10. For at

least these reasons, claim 10 is allowable. Dependent claim 11 is allowable for at least the

reason that this claim depends from and includes the features of allowable independent claim

10.

Independent claim 18 recites:

A system for initiating an instant messaging (IM) session, the system comprising:
a processor; and
memory storage storing program code executed by the processor, the instructions comprising:
a first portion of the program code for receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account;
a second portion of the program code for determining whether the received email message is from the given Internet domain;
a third portion of the program code for determining whether the sender of the received email message is currently present at the instant messaging account;
a fourth portion of the program code for determining whether the sender of the received email message is a contact of a recipient of the received email message;
a fifth portion of the program code for, in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message; and
a sixth portion of the program code, for in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account.

(Emphasis added).

Claim 18 is allowable over *Friskel* in view of *Fang* further in view of *Kirsch* for at least the reason that *Friskel* in view of *Fang* further in view of *Kirsch* fails to disclose, teach, or suggest "a first portion of the program code for receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account" and "a fifth portion of the program code for, in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as emphasized above.

More specifically, *Friskel* discloses that a client user may initiate communications with any sender whose status information indicates that the sender is online and available. *See* col. 7, lines 46-55. *Friskel* does not disclose a rule that specifies that the received email message from the sender needs to be from a given Internet domain in addition to the sender being online. Accordingly, *Friskel* fails to teach or suggest "a first portion of the program code for receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account"

and "a fifth portion of the program code for, in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as recited in claim 18.

Fang does not remedy these deficiencies. For example, *Fang* describes "a framework for allowing personalized rules to be created and deployed to a live web site, through a web interface, without further programming efforts and without interrupting the web site." Paragraph 0044. As such, *Fang* does not disclose or suggest a rule for automatically launching an instant messaging session with a sender of a received email message when the received email message is from a given Internet domain. Further, *Kirsch* describes an email filter that receives an incoming email message and checks whether a sender of the email message is on a whitelist or a blacklist or should be associated with domain names that are on a whitelist/blacklist. See paragraph 0027 and paragraph 0072. Accordingly, the email filter determines whether or not the email message is placed in the recipient's inbox and does not affect outgoing communications from the recipient such as an instant messaging session automatically launched with a sender of a received email message when the received email message is from a given Internet domain. Accordingly, *Kirsch* fails to remedy the deficiencies of *Friskel* and *Fang*.

Moreover, the cited art fails to teach or suggest at least "a sixth portion of the program code, for in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria

specifies that the sender of the received email message is currently present at an instant

messaging account," as recited in claim 18. For at least these reasons, claim 18 is allowable.

Independent claim 26 recites:

> A non-transitory computer-readable storage medium for initiating an instant messaging (IM) session, the computer-readable medium including a program that when executed by a computer performs at least the following:
> ***receiving a rule for handling a received email message, the rule defining first criteria and second criteria, the rule further defining an action to be performed when both the first criteria and the second criteria are satisfied by the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account;***
> determining whether the received email message is from the given Internet domain;
> determining whether the sender of the received email message is currently present at the instant messaging account;
> ***in response to determining that the received email message is from the given Internet domain and the sender of the email message is currently present at the instant messaging account, automatically, without user input, launching an instant messaging session with the sender and bypassing spam filtering of the received email message;*** and
> in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account.

(Emphasis added).

Claim 26 is allowable over *Friskel* in view of *Fang* further in view of *Kirsch* for at least the

reason that *Friskel* in view of *Fang* further in view of *Kirsch* fails to disclose, teach, or suggest

"receiving a rule for handling a received email message, the rule defining first criteria and

second criteria, the rule further defining an action to be performed when both the first criteria

and the second criteria are satisfied by the received email message, wherein the first criteria

specifies that the received email message is from a given Internet domain and the second

criteria specifies that the sender of the received email message is currently present at an instant

messaging account" and "in response to determining that the received email message is from

the given Internet domain and the sender of the received email message is currently present at the instant messaging account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as emphasized above.

More specifically, *Friskel* discloses that a client user may initiate communications with any sender whose status information indicates that the sender is online and available. *See* col. 7, lines 46-55. *Friskel* does not disclose a rule that specifies that the received email message from the sender needs to be from a given Internet domain in addition to the sender being online. Accordingly, *Friskel* fails to teach or suggest "in response to determining that the received email message is from the given Internet domain and the sender of the received email message is currently present at the instant messaging account and "in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an instant messaging session with the sender and bypassing spam filtering of the received email message," as recited in claim 26.

Fang does not remedy these deficiencies. For example, *Fang* describes "a framework for allowing personalized rules to be created and deployed to a live web site, through a web interface, without further programming efforts and without interrupting the web site." Paragraph 0044. As such, *Fang* does not disclose or suggest a rule for automatically launching an instant messaging session with a sender of a received email message when the received email message is from a given Internet domain. Further, *Kirsch* describes an email filter that receives an incoming email message and checks whether a sender of the email message is on a whitelist or a blacklist or should be associated with domain names that are on a whitelist/blacklist. See paragraph 0027 and paragraph 0072. Accordingly, the email filter determines whether or not the email message is placed in the recipient's inbox and does not

affect outgoing communications from the recipient such as an instant messaging session automatically launched with a sender of a received email message when the received email message is from a given Internet domain. Accordingly, *Kirsch* fails to remedy the deficiencies of *Friskel* and *Fang*.

Moreover, the cited art fails to teach or suggest at least 'in response to determining that both the first criteria and the second criteria are not met, executing a spam filter on the received email message, wherein the first criteria specifies that the received email message is from a given Internet domain and the second criteria specifies that the sender of the received email message is currently present at an instant messaging account," as recited in claim 26. For at least these reasons, claim 26 is allowable. Dependent claim 27 is allowable for at least the reason that this claim depends from and includes the features of allowable independent claim 26.

CONCLUSION

For at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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